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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,857	05/03/2001	Hideki Itaya	HCDI1785	9838

7590 04/21/2005

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EXAMINER

LUDLOW, JAN M

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/849,857

Applicant(s)

ITAYA ET AL.

Examiner

Jan M. Ludlow

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-18 is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/18/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/18/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. The drawing corrections were received on January 18, 2005. These drawing corrections are approved.
2. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the disclosure as originally filed for the diagnostic carousel including both a diagnostic vessel and a pipette. The terms "diagnostic vessel" and "pipette" are both used in the disclosure to refer to the pipettes. The amendment therefore constitutes new matter. Note that applicant has not described any other diagnostic vessels, or how to make or use the invention using a diagnostic vessel other than a pipette.
3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 1 and 7, the examiner notes that there is no disclosure of both pipettes and diagnostic vessels, but rather both terms have been used for the same structure in the specification. It is therefore unclear what applicant intends in claiming both pipettes and diagnostic vessels, in that they are disclosed as the same thing. In claim 1, last line "other diagnostic vessel" is unclear because it is unclear if this is the same or different form the previously recited diagnostic vessel.

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4. Claims 1-9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action.

5. The following claim amendments drafted by the examiner and considered to distinguish patentably over the art of record in this application, are presented to applicant for consideration:

In claim 1, line 5, change "diagnostic vessel" to --pipette--.

In claim 1, line 6, delete "and a pipette".

In claim 1, line 8, change "diagnostic vessel" to --pipette--.

In claim 1, line 10, change "diagnostic vessel" to --pipette--.

In claim 1, line 12, delete "or other diagnostic vessel".

Cancel claim 2.

In claim 7, lines 2-3, delete "or other diagnostic vessels".

6. Claims 10-18 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach or suggest the invention as claimed. References cited below constitute the closest prior art and the instant claims define over these references as explained below.

8. Note that for purposes of examination, the claims have been interpreted such that "carousel" means "a rotatable circular device," in accordance with its common definition, and its usage in the instant disclosure. Thus, the limitations in claims 13 and 15 to "rotatable" carousels are seen as further emphasis of this point, but are not

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interpreted to imply that the carousels of the remaining claims may be fixed circular structures.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Seshimoto teaches sample vessels 6 on conveyor 7 and pipettes 3 (i.e., aspiration tubes) connected to circular manifold 1 which may be rotated ([0067]). The conveyor may convey disc shaped racks [0071-0072], making obvious a circular conveyor or carousel. However, instant claims 1 and 10 require that the pipette or diagnostic vessel contact the sample tube, whereas in Seshimoto, the pipette contacts a filter inserted in the sample tube. Note that the filter of Seshimoto is not considered a sample tube as claimed because it cannot contain or store sample by virtue of its open bottom end—the tube 6 contains the fluid. With respect to claim 15, transfer of fluid is not directly from the sample tube to the pipette as claimed because the filter is between the tube and the pipette.

11. Jordan (4325910) teaches a sample turntable 32 offset from reagent turntable 26 and reaction turntable 12, but transfer is performed by pipettes 18, 20, 22 fixed in an arc of an inner circle (i.e., not on a carousel as instantly claimed, because the fixed circle is not a conveyor).

12. Wakatake (5183638) teaches rotatable arms carrying pipettes over carousels for fluid transfer, but the term “carousel” in the instant claims is interpreted to define over an arm, in that the arm moves in an arc, but is not itself circular.

13. Rokugawa (4844868) teaches sample carousel 14 below reagent turntables 64, but transfer is from pipette 32 to sample tube 4, not from sample tube to pipette (diagnostic vessel) as claimed. Note further that check valves (Fig 5) prohibit transfer into the pipettes.

14. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

With respect to applicant's comment on the examiner's explanation of the claim interpretation with respect to "carousel" found in paragraph 9 of the previous office action, applicant's comment is not understood. The examiner has merely clarified the common meaning of the term "carousel" and there is therefore no "added interpretation other than the words listed" in the claim. Applicant has not argued that the term "carousel" means something different from the meaning used by the examiner in interpreting the claims in accordance with the meaning of the words in the claims.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (571) 272-1260. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jan M. Ludlow
Primary Examiner
Art Unit 1743

Jml
April 18, 2004



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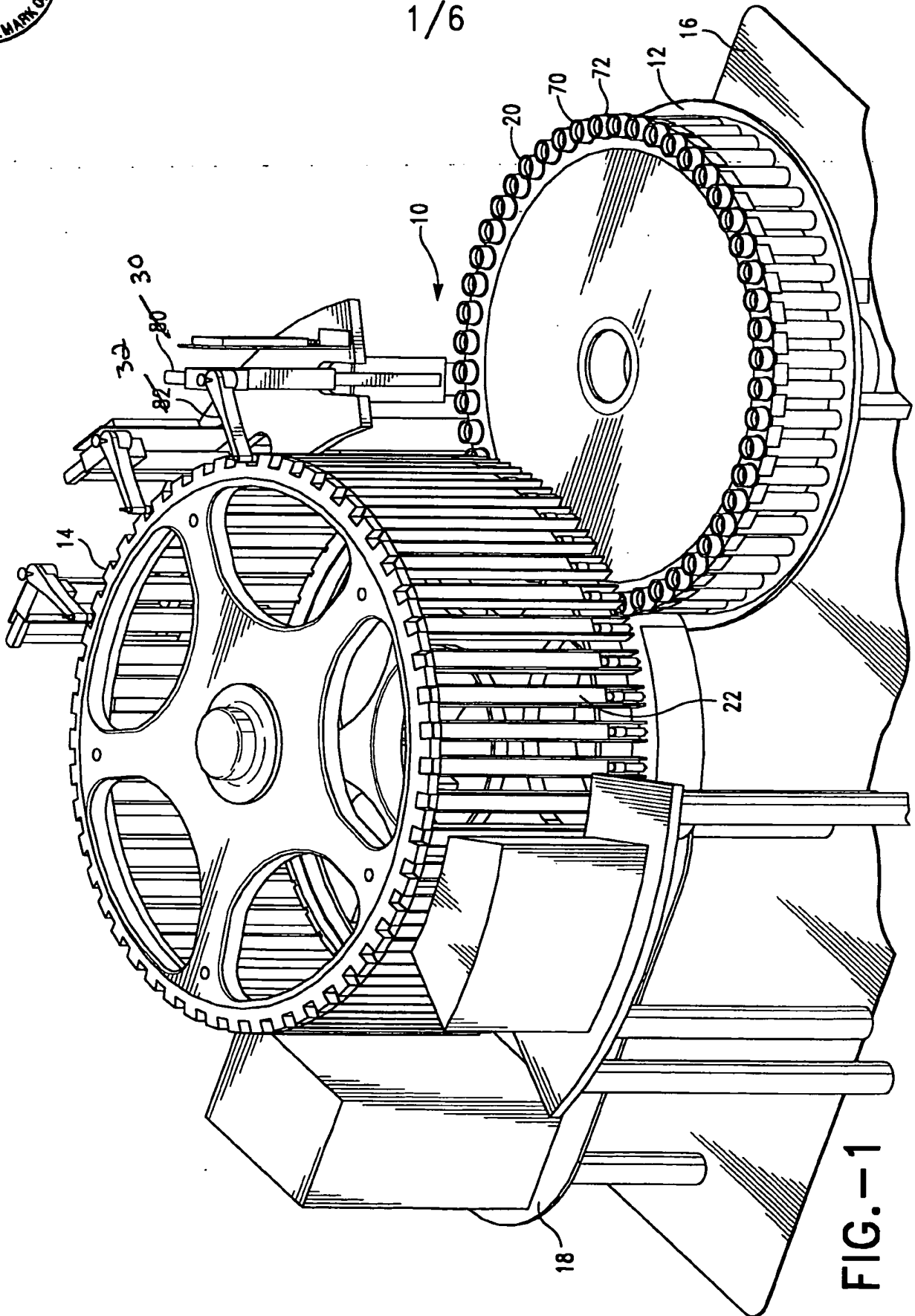


FIG.-1

approved by 2/21/05



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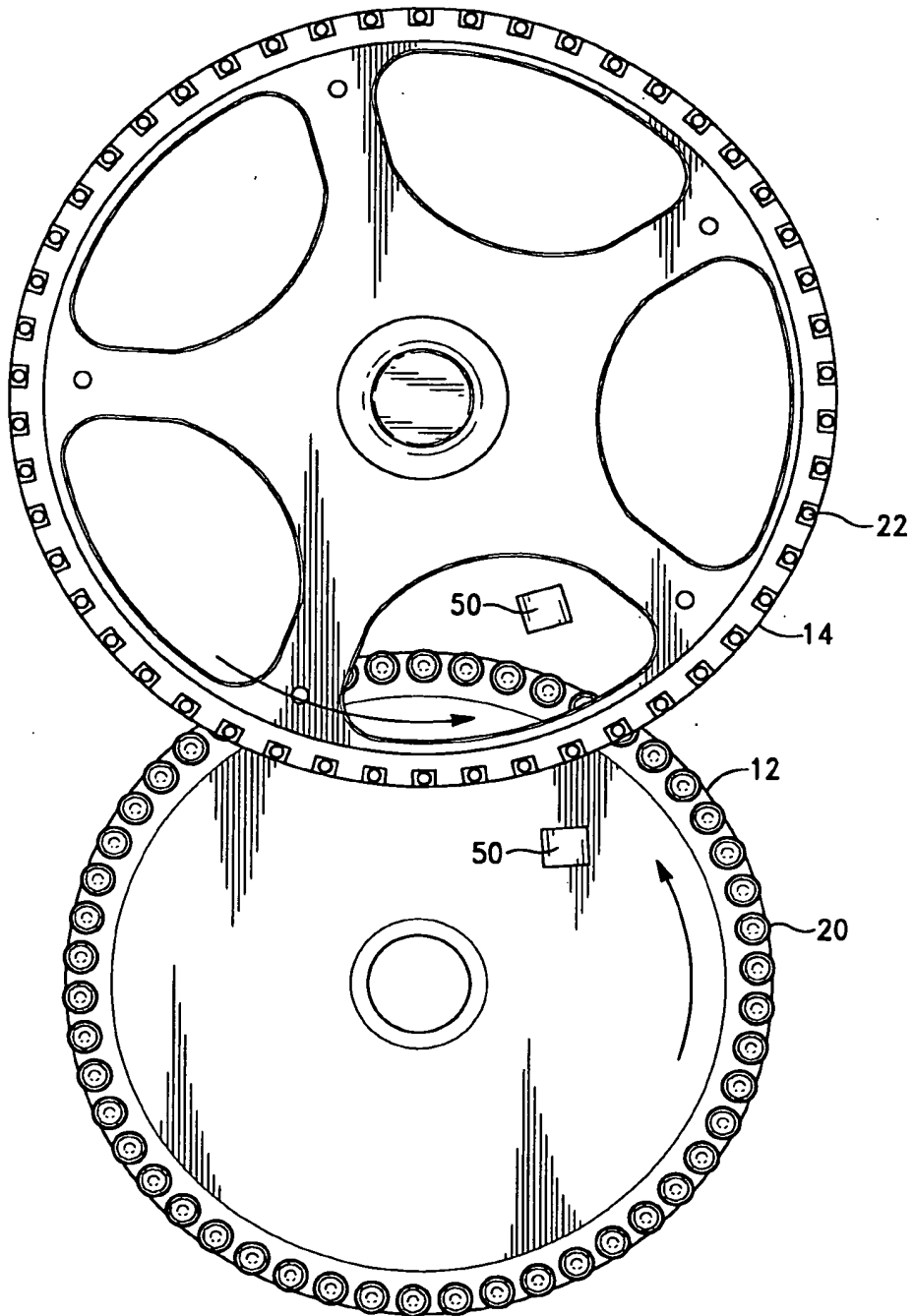


FIG.-2

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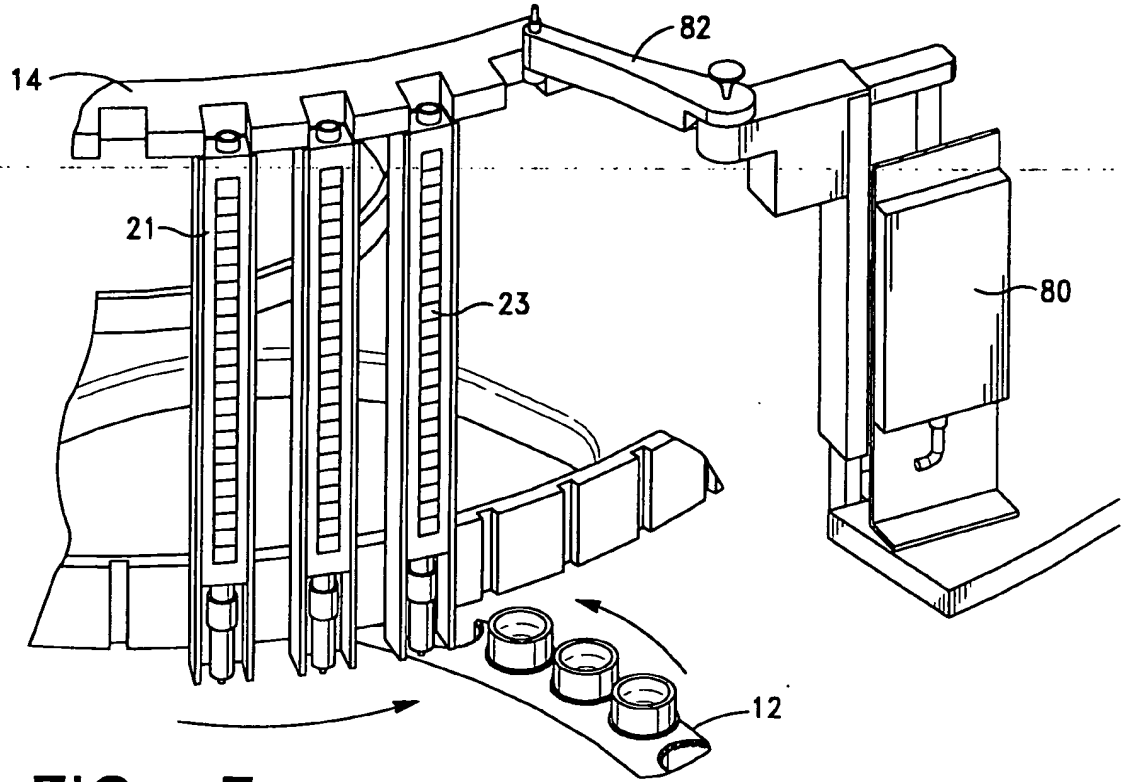


FIG.-3

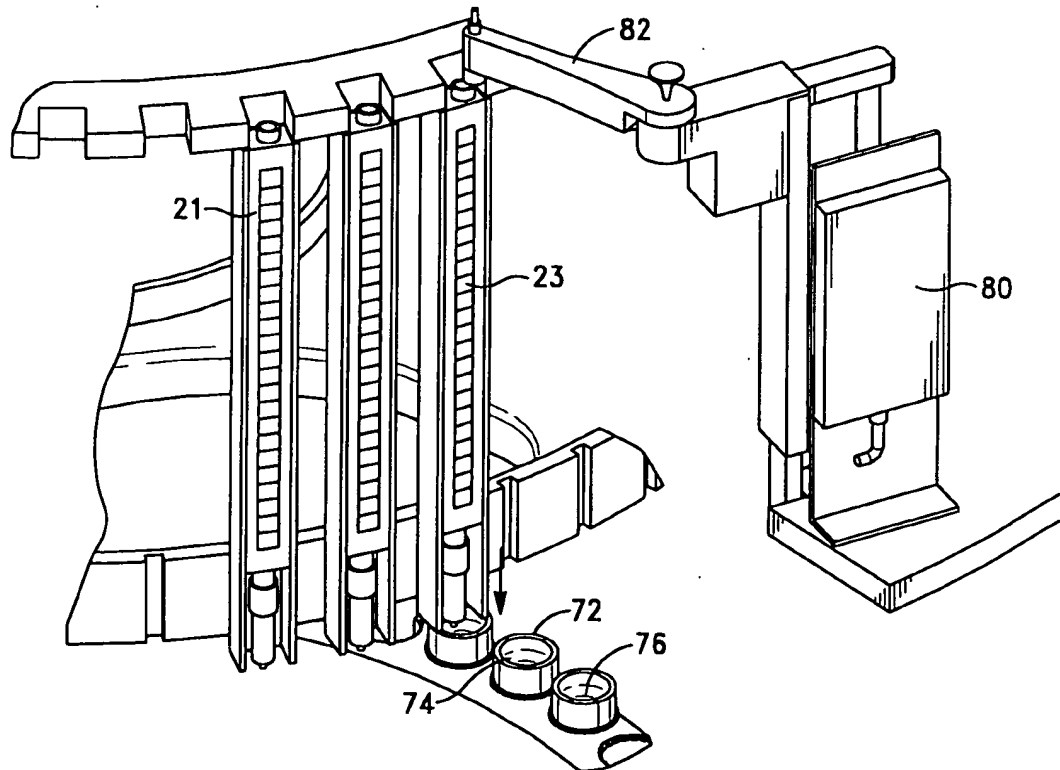


FIG.-4



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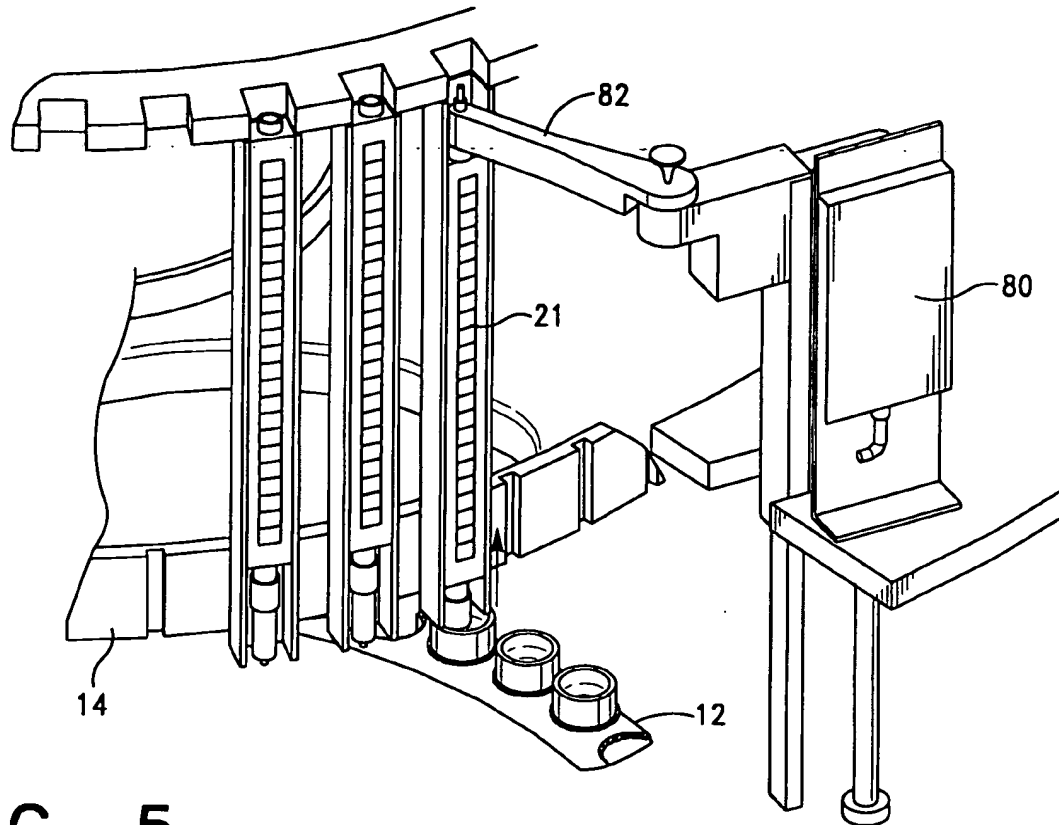


FIG.-5

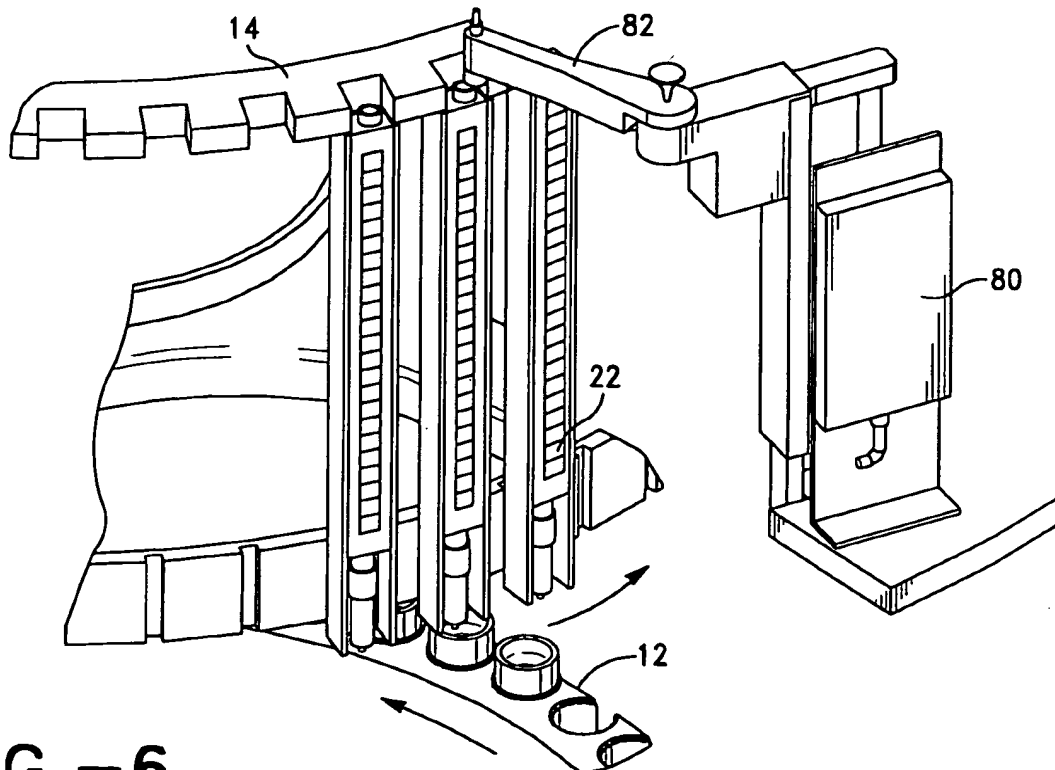
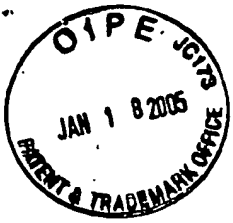


FIG.-6

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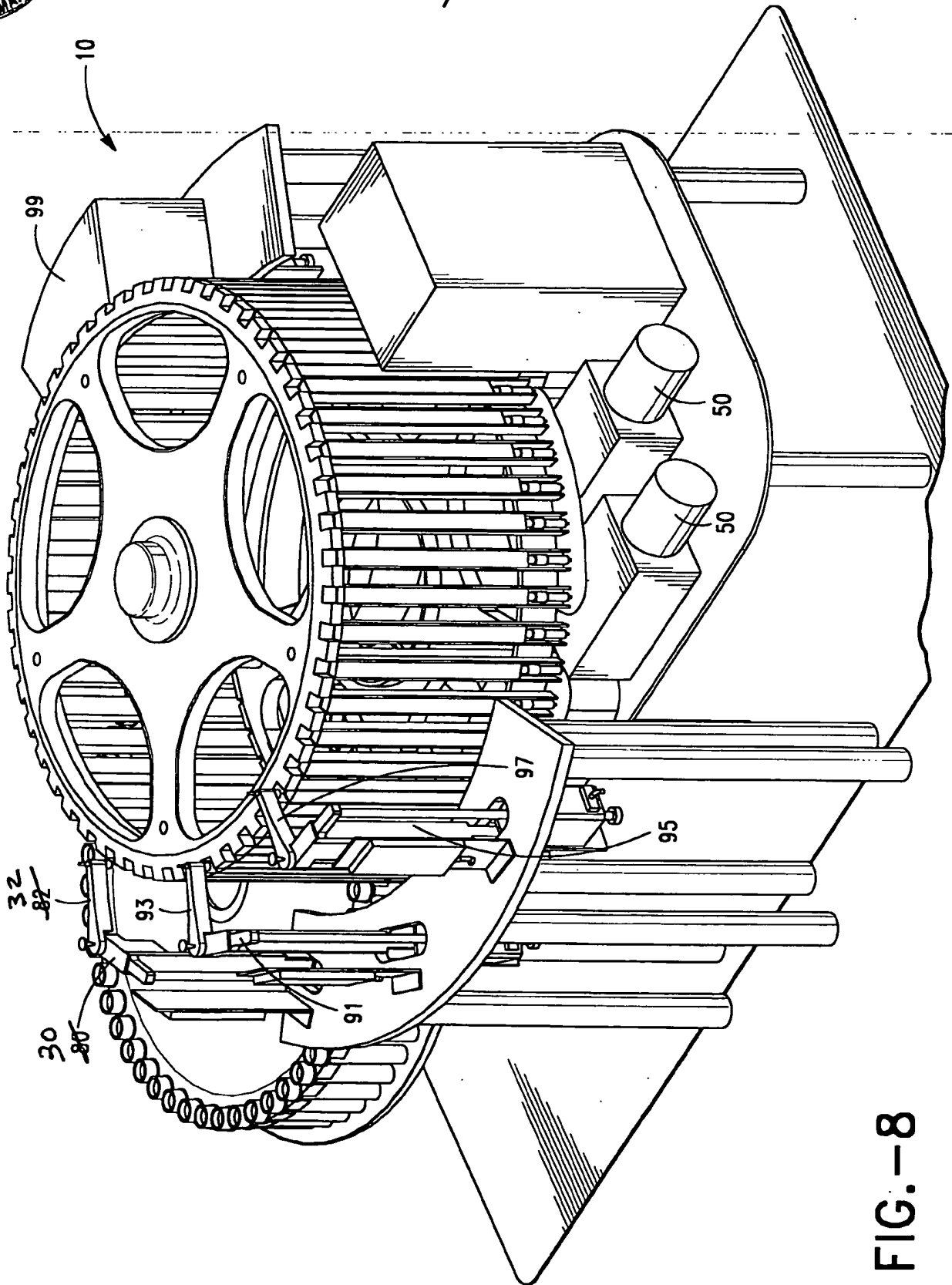


FIG.-8

approved
2/21/05